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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/625,647	07/26/2000	Shashi Ramamurthy	411951-185	6325

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EXAMINER
YANG, CLARA I

ART UNIT	PAPER NUMBER
2635	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/625,647	Applicant(s) RAMAMURTHY ET AL.	
	Examiner Clara Yang	Art Unit 2635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 July 2000* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *26 July 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2, 3, 8, and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "said communicating instruction" in lines 18 - 19. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation "said communicating instruction" in line 22. There is insufficient antecedent basis for this limitation in the claim.

Claim 8 recites the limitation "said communicating instruction" in lines 23 - 25. There is insufficient antecedent basis for this limitation in the claim.

Claim 9 recites the limitation "said communicating instruction" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1, 4, and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by McDonald U.S. Patent No. 6,211,781.

Referring to Claim 1, McDonald's tag reader 102 or radio frequency identification (RFID) reader, as shown in Figs. 1 and 4, comprises: (a) antenna 402, receiver 404, and transmitter 408 that form a radio module; and (b) a processor 406 for providing transmit and receive commands to transmitter 408 and receiver 404 respectively (see Col. 4, lines 16 -18). Because McDonald also discloses that processor 406 is programmed to periodically transmit an interrogation signal without waiting for an instruction from network 117, it is implied that tag reader 102 further comprises either (c) an internal or external memory for storing such program instructions. McDonald teaches that tag reader 102's program instructions include: (d) detecting data loaded in the memory of at least one RFID tag (see Col. 4, lines 15 - 16 and Col. 5, lines 41 - 44); and (e) communicating information to external systems connected via network 117 (see Col. 4, lines 19 - 26 and Col. 6, lines 17 - 23, 29 - 47, and 51 - 61).

Regarding Claim 4, the program instructions of McDonald's tag reader 102 additionally includes periodically transmitting an interrogating signal to communicate with RFID tags (see Col. 4, lines 46 - 48 and Col. 5, lines 31 - 44).

Referring to Claim 15, McDonald's method for reading an RFID tag comprises: (a) interrogating an RFID tag (see Fig. 3, step 302 and Fig. 5, steps 502, 504, and 506); (b) receiving information, including unique identification code or identifying data, stored in memory of an RFID tag (see Fig. 3, step 306; Fig. 5, steps 508 and 510; and Col. 3, lines 56 - 57); and (c) processing the received RFID tag information in accordance with its identifying data (see Col. 7, lines 9 - 15).

5. Claims 1 - 11 and 15 - 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Holtzman et al. U.S. Patent No. 6,400,272.

Referring to Claims 1 and 5 - 7, Holtzman discloses an RFID reader 15, as shown in Figs. 1, 2, and 5, comprising: (a) transceiver 118 or radio module; (b) microcontroller 112 or processor connected to transceiver 118 for providing transmit and receive commands to transceiver 118 (see Col. 7, lines 48 - 67; Col. 8, lines 1 - 67; and Col. 9, lines 1 - 42); and (c) main memory 54 for storing program instructions (see Col. 4, lines 15 - 17 and 33 - 35). Holtzman teaches that RFID reader 15's program instructions include: (d) detecting data received from at least one RFID tag (see Col. 3, lines 14 - 25; Col. 7, lines 59 - 67; and Col. 8, lines 1 - 4); and (e) communication information to servers 30a - 30c or external systems via Internet Protocol (IP) network 25 (see Col. 3, lines 57 - 67; Col. 4, lines 1 - 12). As shown in Fig. 1, Holtzman's computer network comprises: (a) servers 30 having a plurality of application programs (see Col. 4, lines 2 - 12; Col. 6, lines 25 - 30; and Col. 12, lines 4 - 17); (b) at least one client computer 10 connected to servers 30 via IP network 25; and (c) an RFID reader 15 connected to servers 30 via client computer 10 and IP network 25. Holtzman's RFID reader 15 is adapted to communicate with RFID tags having a memory and provides a message to servers 30 regarding one of the RFID tags directed

to an application program selected in accordance with data stored in the RFID tag (see Col. 3, lines 3 - 7 and 25 - 56; Col. 4, lines 2 - 12; Col. 11, lines 41 - 55; and Col. 12, lines 4 - 7).

Regarding Claims 2 and 8, Holtzman teaches that RFID reader 15 receives RFID tag data containing access criteria that direct users to a specific remote node, such as an email server or a web site, thus implying that RFID tag data includes an address of a particular remote node or destination computer system connected to IP network 25. Holtzman's RFID reader 15 communicates information regarding an RFID tag to the destination system. (See Col. 3, lines 57 - 67; Col. 4, lines 1 - 12; Col. 11, lines 22 - 55; and Col. 12, lines 28 - 36 and 55 - 58.)

Regarding Claims 3 and 9, Holtzman also imparts that RFID reader 15 receives RFID tag data containing a protocol used by at least one RFID tag and communicates with the RFID tag in accordance with the specified protocol (see Col. 1, lines 49 - 64; Col. 7, lines 59 - 67, Col. 8, lines 1 - 67; and Col. 9, lines 1 - 42).

Regarding Claims 4 and 10, per Holtzman, the program instructions for RFID reader 15 further include periodically transmitting an interrogation signal to communicate with RFID tags (see Col. 9, lines 8 -12).

Regarding Claim 11, Holtzman expresses that at least one of the application programs is an email program for sending an email message to a destination computer identified by the data (see Col. 11, lines 41 - 55).

Referring to Claim 15, Holtzman's method for reading an RFID tag comprises: (a) interrogating an RFID tag (see Col. 3, lines 3 - 7); (b) receiving RFID tag information that includes identifying data (see Col. 3, lines 14 - 25); and (c) processing the RFID tag information in accordance with the identifying data (see Col. 11, lines 32 - 34 and 48 - 52; and Col. 12, lines 10 - 17).

Regarding Claim 16, Holtzman's method also includes communicating an RFID tag's stored information with a destination system indicated by a destination address contained in the RFID tag's data (see Col. 9, lines 55 - 62; Col. 11, lines 15 - 21, and 32 - 55; Col. 12, lines 28 - 36 and 55 - 58).

Regarding Claim 17, Holtzman states that an RFID tag's identifying data defines a protocol used by the RFID tag and communicates stored information in accordance with the protocol (see Col. 3, lines 40 - 56; Col. 7, lines 59 - 67; Col. 8, lines 1 - 67; and Col. 9, lines 1 - 42).

Regarding Claim 18, Holtzman discloses that an RFID tag's identifying data further defines a software application used for processing the stored information and communicates the stored information to the software application (see Col. 6, lines 25 - 30; Col. 11, lines 41 - 55; and Col. 12, lines 4 - 21).

Regarding Claim 19, Holtzman imparts that an RFID tag's access criteria can include a Uniform Resource Locator (URL) for an email server or a web page (see Col. 3, lines 57 - 67; Col. 9, lines 55 - 62; Col. 4, lines 40 - 46; Col. 10, lines 23 - 30; and Col. 11, lines 32 - 40). Because a URL is a textual address that is translated into correlating IP address via a domain name server, it is understood that RFID tag's access criteria comprises an IP address.

Regarding Claim 20, because Holtzman teaches that computer 10 and a remote node use hypertext transfer protocol (HTTP) to communicate (see Col. 10, lines 18 - 23), it is understood that an RFID tag's access criteria also includes a protocol identifier comprising Port Number 80 to indicate the use HTTP.

Referring to Claim 21, Holtzman's RFID tag or transponder comprises either a read-only memory or an electrically erasable programmable read-only memory (EEPROM) for storing a unique digital identifier (see Col. 3, lines 17 - 39), a protocol identifier (see Col. 8, lines 22 - 37

and 51 - 58), and at least a destination address identifier (see Col. 6, lines 11 - 14; Col. 9, lines 30 - 32 and 55 - 62; Col. 11, lines 32 - 40 and 48 - 55; and Col. 12, lines 28 - 36).

Regarding Claim 22, Holtzman imparts that an RFID tag's access criteria can include a Uniform Resource Locator (URL) for an email server or a web page (see Col. 3, lines 57 - 67; Col. 9, lines 55 - 62; Col. 4, lines 40 - 46; Col. 10, lines 23 - 30; and Col. 11, lines 32 - 40). Because a URL is a textual address that is translated into correlating IP address via a domain name server, it is understood that RFID tag's access criteria comprises an IP address as a destination address identifier.

Regarding Claim 23, because Holtzman teaches that computer 10 and a remote node use hypertext transfer protocol (HTTP) to communicate (see Col. 10, lines 18 - 23), it is understood that an RFID tag's access criteria also includes a protocol identifier comprising Port Number 80 to indicate the use HTTP.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 12 - 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holtzman et al. U.S. Patent No. 6,400,272 as applied to Claim 5 above, and further in view of McDonald U.S. Patent No. 6,211,781.

Regarding Claim 12, Holtzman fails to teach that an email message sent from computer 10 to a remote node contains at least one of time and date of communication by RFID reader 15 and the RFID tag.

In an analogous art, McDonald's tag reader 102 sends tag information to network 17. According to McDonald, the information includes the tag code, a tag reader code, and date and time tag reader 102 received the response signal from the tag (see Col. 4, lines 19 - 26 and Col. 6, lines 17 - 23).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the computer network of Holtzman as taught by McDonald because providing time and date data enables the network to track the frequency and locations of tag usage, thus improving the network's tracking function.

Regarding Claims 13 and 14, one of Holtzman's plurality of application programs include a web browser 80 (see Fig. 2) and website hosting programs at servers 30 (see Col. 5, lines 21 - 26; Col. 11, lines 15 - 21; and Col. 12, lines 28 - 36). Holtzman teaches that RFID tag information is only available to a computer system identified in the RFID tag data (see Col. 4, lines 5 - 8; and Col. 11, lines 32 - 40 and 48 - 55) and also teaches the RFID tag information be displayed on computer 10 (see Col. 13, lines 50 - 63). Holtzman, however, is silent on a website hosting program for posting information on a website regarding an RFID tag.

McDonald's computer network 117 comprises the Internet or an intranet and allows a user to view the location or replay the location history of any mail piece that is affixed to tag 119 (see Col. 6, lines 35 - 44 and 51 - 64). Here it is understood that the location and location history data of each mail piece are posted on a website for a user to access either via the Internet or an intranet.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the computer network of Holtzman as taught by McDonald because posting tag information on a website improves a user's accessibility to tag data.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Matsui et al. U.S. Patent No. 4,924,210: Matsui teaches an RFID tag that transmits a response signal containing a protocol identifier to a reader.
- Rodgers et al. U.S. Patent No. 6,362,737: Rodgers discloses an object identification system that uses a plurality of protocols between the reader and RFID tags. The reader establishes the protocol to be used with a specific tag by transmitting an access code along with a level code.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clara Yang whose telephone number is (703) 305-4086. The examiner can normally be reached on 8:30 AM - 7:00 PM, Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (703) 305-4704. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

CY
February 3, 2003

BRIAN ZIMMERMAN
PRIMARY EXAMINER